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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/633,521	05/11/97	MARK A. STOHL	YI 14032-082970

D. C.  
DURCH STEWART VOLASICK & DURCH  
P. O. BOX 747  
VALLEY CHURCH, VA 22040-0747

DAMY /0911

EXAMINER

YOCOK, T

ART UNIT

PAPER NUMBER

1511

DATE MAILED:

09/11/97

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. <b>08/815,592</b>	Applicant(s) <b>Maruta et al</b>
	Examiner <b>Tae H. Yoon</b>	Group Art Unit <b>1511</b>

- Responsive to communication(s) filed on \_\_\_\_\_.
- This action is **FINAL**.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- Claim(s) 1-21 is/are pending in the application.
- Of the above, claim(s) 9-21 is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 1-8 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been  received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- \*Certified copies not received: \_\_\_\_\_
- Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- Notice of References Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s). 2
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, drawn to a combination of powders, classified in class 523, subclass 205+.
- II. Claims 9-21, drawn to a method of coating, classified in class 427, subclass 407.1+.

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a rotational molding composition as evidenced by EP 87 204.

Because these inventions are distinct for the reasons given above and the search required for invention II is not required for invention I restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Faraci on September 2, 1997 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-8. Affirmation of this election must be made by applicant in responding to this Office action. Claims 9-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited language is not clear in claim 1, and thus the insertion of "made" or "obtained" after "homogeneous hue" is suggested, for example. In claim 8, the recite "---composition comprising two or more powder coatings selected from the combination of ---" is confusing since it is not clear whether said composition means "the combination (mixture) of powder coatings" or "the combination (mixture) of powder coating mixtures of claims 1-7".

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Morgan et al (US 5,319,001).

Morgan teaches colored powder coating compositions comprising a mixture of particles of at least two different colors at col. 1, line 60 to col. 2, line 2. Morgan is silent as to the recited properties of powder coatings, but the Examiner believes that said properties are inherently present in the powder coating compositions of Morgan since Morgan teaches that the basic color powder coating compositions used to form the mixtures should have similar melting point, melt viscosity, surface tension and other rheological properties to one another so that they flow and level to same extent when the powder coating is applied to a substrate at col. 3, lines 40-48. The instantly recited properties are related to rheological properties.

Thus, applicants' invention lacks novelty, and the use of the recited range of properties is an obvious to one of ordinary skill in the art at the time of invention since Morgan teaches the use of mixtures having similar properties.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fitzgerald (US '571) alone, or in view of Morgan et al.

Fitzgerald teaches a powder coating composition containing at least two different colored powders in abstract and examples. The instantly recited properties are inherently present in powder coating compositions of Fitzgerald. Morgan teaches the mixtures of powder coatings having similar properties.

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Thus, applicants' invention lacks novelty, and it would have been obvious to one ordinary skill in the art at the time of invention to utilize powder coatings having similar properties in Fitzgerald in order to obtain homogeneous colors with or without teaching of Fitzgerald since it is well known as evidenced by Morgan absent showing otherwise.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 87 204.

EP teaches a mixture of polymeric powders having different pigments in abstract and examples. The Examiner's position is that the powders of EP inherently possess the recited properties. The instant invention further recites the use of white-colored powder and non-white-colored powder over EP.

Thus, applicants' invention lacks novelty, and it would have been obvious to one of ordinary skill in the art at the time of invention to utilize a white pigment and non white pigment in EP since EP teaches the use of pigments having different colors and since the use of pigments having different colors depending on the desired final color is considered a routine absent showing otherwise.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Mon-Thr from 8:00 to 5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for this Group is (703) 305-5433.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [[vasu.jagannathan@uspto.gov](mailto:vasu.jagannathan@uspto.gov)].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2351.



THY/September 2, 1997

TAE YOON  
PRIMARY EXAMINER  
GROUP 1500